



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,251	01/09/2002	Katsumasa Harada	740709-493	8831

22204 7590 03/30/2004

NIXON PEABODY, LLP
401 9TH STREET, NW
SUITE 900
WASHINGTON, DC 20004-2128

EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
----------	--------------

1624

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/030,251	Applicant(s) HARADA ET AL.	
	Examiner Brenda L. Coleman	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-22 is/are pending in the application.
- 4a) Of the above claim(s) 10, 11 and 14-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-7 and 9-22 are pending in the application.

Election/Restrictions

1. Applicant's election without traverse of Group I in the paper filed January 12, 2004 is acknowledged.
2. Claims 10, 11 and 14-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the paper filed January 12, 2004.

Information Disclosure Statement

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Priority

4. Any non-provisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior application, identifying

it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross - references to other related applications may be made when appropriate.

"This application is a national stage entry under 35 U.S.C. § 371 of PCT/JP99/03719, filed July 9, 1999." is suggested.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The addition of claim 13 where the dehydration-condensation reaction is conducted in a hydrophobic solvent and by azeotropic distillation is not described in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Art Unit: 1624

6. Claims 1-7, 9, 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reason(s) apply:

- a) Claim 1 and claims dependent thereon are vague and indefinite in that it is not known what is meant by "s" in the first line of claim 1.
- b) Claims 1-7, 9, 12 and 13 are vague and indefinite in that "derivative" in claims 1-7, 9, 12 and 13 implies more than what is positively recited.
- c) Claim 1 and claims dependent thereon are vague and indefinite in that it is not known what is meant by "the following formula (2)" when there is no formula (2) in the claim.
- d) Claim 1 and claims dependent thereon are vague and indefinite in that it is not known what is meant by 2' in the nomenclature of formula (3) and formula (4) on page 3 of the amendment filed January 12, 2004.
- e) Claim 3 is vague and indefinite in that it is not known what is meant by the comma after "The process of the," in line 1 of claim 3.
- f) Claim 3 is vague and indefinite in that it is not known what is meant by 2' in the nomenclature of formula (3).
- g) Claims 3, 6 and 12 are vague and indefinite in that it is not known what is meant by palladium and platinum, which is embraced by palladium compound and platinum compound and thus results in double inclusion. See Ex parte White 127 USPQ 261.

- h) Claim 4 is vague and indefinite in that it is not known what is meant by 2 – amino – carboxy – diphenylsulfide of formula (4).
- i) Claim 4 recites the limitation "carboxy" in the nomenclature of formula (4). There is insufficient antecedent basis for this limitation in the claim.
- j) Claim 5 and claims dependent thereon are vague and indefinite in that it is not known what is meant by alkoxy in the definition of R^1 , R^2 , R^3 , R^4 , R^5 , R^6 , R^7 and R^8 .
- k) Claim 5 and claims dependent thereon are vague and indefinite in that it is not known what is meant by 2' in the nomenclature of formula (3).
- l) Claim 5 and claims dependent thereon are vague and indefinite in that it is not known what is meant by 22 – amino – 2' – carboxy-diphenylsulfide of formula (4).
- m) Claim 4 recites the limitation "22 - amino" in the nomenclature of formula (4). There is insufficient antecedent basis for this limitation in the claim.
- n) Claim 5 and claims dependent thereon are vague and indefinite in that it is not known what is meant by "the following formula (4)" when there is no formula (4) in the claim.
- o) Claim 5 and claims dependent thereon are vague and indefinite in that it is not known what is meant by 2 –amino- 2' carboxy-diphenyl-sulfide.
- p) Claim 6 is vague and indefinite in that it is not known what is meant by 2 – nitro- 2' carboxy-diphenyl-sulfide of formula (3).

Art Unit: 1624

- q) Claim 6 is vague and indefinite in that it is not known what is meant by de-derivative.
- r) Claim 7 is vague and indefinite in that it is not known what is meant by canboxy.
- s) Claim 12 is vague and indefinite in that it is a duplicate of claim 6.
- t) Claim 12 is vague and indefinite in that it is not known what is meant by corn-pound.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 4, 5, 7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Allen et al., Journal of Medicinal Chemistry. Allen teaches the process of preparing the compounds of formula (5) by reacting 4-chloro-3-nitro-5-sulfamylbenzoic acid with thiosalicyclic acid to obtain 4-(2-carboxyphenylthio)-3-nitro-5-sulfamylbenzoic acid and reducing 4-(2-carboxyphenylthio)-3-nitro-5-sulfamylbenzoic acid to obtain 3-amino-4-(2-carboxyphenylthio)-5-sulfamylbenzoic acid, which is then converted into 8-methoxycarbonyl-6-sulfamyl-dibenzo[b,f][1,4]thiazepin-11(10H)-one.

Art Unit: 1624

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00 Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brenda Coleman
Primary Examiner Art Unit 1624
March 26, 2004